



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/761,594 | 01/21/2004 | Peter Hanosek | 13745 | 4257 |

7590 02/14/2006
ORUM & ROTH
53 W. JACKSON BLVD
CHICAGO, IL 60604

EXAMINER

MAYES, DIONNE WALLS

ART UNIT PAPER NUMBER

1731

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,594

Applicant(s)

HANOSEK ET AL.

Examiner

Dionne Walls Mayes

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9, 11-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "few", in claims 1 and 11, is a relative term which renders the claim indefinite. The term "few" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-5, 8-9, 11, 17-18, 28, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegen et al (U.S. Patent No. 6,431,177).

Regarding claims 1 and 30, Siegen teaches an extinguisher for smokers, characterized by a bar-shaped container (Figures 4a-4c) with an opening on one end that is closed by a removable closure body (1st and 2nd hollow cylindrical members in combination, see Figures 4c and 5) which consists, in full or predominantly, of a

Art Unit: 1731

material resistant to the glowing ash of cigarettes or cigars (column 3, lines 9-12).

Sieggen fails to teach an ash collector for smokers. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that the invention of Sieggen is capable of performing the function of collecting ash for smokers as it the instant application. Also, while Sieggen may not explicitly state that the thermal capacity of its extinguisher closed end is selected to ensure that embers of a cigarette or a cigar will be extinguished within a few seconds, the Examiner believes that Sieggen's extinguisher meets this limitation. Since the phrase "few seconds" can mean different things to different observers, its clear that the Sieggen extinguisher would extinguish the embers of a smoking article placed therein in a "short" amount of time due to the fact that ambient air is not allowed to enter the device to fuel the combustion of the article. Therefore, the Examiner feels that the disclosure would read on the claims based on the Examiner's interpretation of the phrase "a few seconds". Accordingly, claims 1 and 30 are rejected.

Regarding claim 2, Sieggen teaches that the closure body is made from metal (column 3, lines 9-12). Accordingly, claim 2 is rejected.

Regarding claim 4, Sieggen teaches the closure body has a recess on its end facing the interior of the container (container indicated by reference number 40 in all Figures)(Figure 5). Accordingly, claim 4 is rejected.

Regarding claim 5, Sieggen fails to teach the recess of the closure body tapers from its end toward the interior of the closure body. However, due to a lack of criticality

Art Unit: 1731

and unexpected results, the tapering of the recess of the closure body is a matter of design choice. Accordingly, claim 5 is rejected.

Regarding claim 8, Sieggen teaches the closure body is a plug (Figure 4c). Accordingly, claim 8 is rejected.

Regarding claim 9, Sieggen teaches that the first hollow cylindrical member (the closure body) fits in the third hollow cylindrical member in a friction fit relationship. The flange (reference number 26 in Figures) acts as a seal, preventing air from entering the enclosure formed by the first and third members when slidably coupled (column 3, lines 41-43). Sieggen fails to teach the outer surface of the closure body is provided with a groove, which is intended to receive a sealing ring. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to design the outer surface of the closure body with a groove that would accommodate a sealing ring thereby providing a sealing alternative to the flange used by Sieggen. Accordingly, claim 9 is rejected.

Regarding claims 11 and 31, Sieggen teaches that closure body is designed such that the heat from a lit cigarette is not efficiently transferred to the non-heat resistant surface of the first member and is not felt by the user. Sieggen fails to expressly teach that the thermal capacity of the closure body is selected to ensure that when a cigar or a cigarette is stubbed out in the recess of the closure body, the temperature of its outer surface will not rise above 50° Celsius. However, because Sieggen indicates that the heat is not felt by the user obviously means that the heat of

Art Unit: 1731

the outer surface of the closure body will not rise above 50° Celsius. Accordingly, claims 11 and 32 are rejected.

Regarding claims 17, 18 and 32, Sieggen fails to teach any specific size of the outer diameter or length of the container. However, due to a lack of criticality or unexpected results, it would be obvious to one of ordinary skill in the art to design the container with an outer diameter and a length large enough to easily accommodate the entire length of the cigarette or cigar, but small enough so that the device would not be bulky and awkward. Accordingly, claims 17, 18 and 32 are rejected.

6. Claims 3, 13-16 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sieggen in view of Lustbader (U.S. Patent No. 3,405,719).

Sieggen fails to teach any particular metal out of which the closure body would be made. However, Lustbader teaches a device for retaining ashes (an ashtray) that is made from a metal with a high thermal conductivity, such as aluminum or brass. Lustbader fails to teach a closure body being made from a metal with a high thermal conductivity. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to take the teaching of Sieggen (a bar-shaped container that may be used as an ash collector) and combine it with the teaching of Lustbader to design an ash collector with a closure body that is made from a metal with high thermal conductivity, such as an aluminum, copper, or brass because high thermally conducting metals will better resist the heat of the ashes coming into contact with the container and the closure body. Additionally, the use of a closure body keeps the ashes in the container. Accordingly, claim 3 and 29 is rejected.

Art Unit: 1731

Regarding claims 13, 14 and 15, Lustbader teaches the container is made from aluminum, which is a metal suited from deep-drawing (column 3, lines 17-18).

Accordingly, claims 13-15 are rejected.

Regarding claim 16, Lustbader teaches the container is a molded plastic part (column 3, lines 19-21). Accordingly, claim 16 is rejected.

7. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sieggen in view of Nicotra (U.S. Patent No. 5,862,809).

Sieggen fails to teach that the recess in the closure body (a snuffer) has a particular shape. Nicotra teaches the use of a snuffer that is of a bowl or convex shape, preferably of a truncated cone (column 2, lines 38-43). Nicotra fails to teach that the snuffer is in the closure body. However, it would have been obvious to one of ordinary skill in the art to combine the teachings of Sieggen with the teachings of Nicotra to design a ash collector with a closure body that is used as a cigarette/cigar snuffer. Moreover, it would have been obvious to design the snuffer or closure body with a shape that would be most effective in extinguishing the cigarette or cigar whether concave or conical in shape. Accordingly, claims 6 and 7 are rejected.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sieggen in view of Herrmann (U.S. Patent No. 5,499,634).

Sieggen teaches a clip attached to the container. Sieggen fails to teach a clip attached to the closure body. However, Herrmann teaches a clip attached to the closure body or cap. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Sieggen with the teaching of Herrmann

Art Unit: 1731

to attach the clip to the closure body of the ash container so that the ash container could be upright at all times so that when the container is opened the ashes would not come out of container onto the user. Accordingly, claim 12 is rejected.

9. Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sieggen in view of Kojima (U.S. Patent No. 4,996,995).

Regarding claim 20, Sieggen fails to teach an ash collector comprising an integrated flashlight. However, Kojima teaches an ashtray, which has a light means, i.e. an integrated flashlight. It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Sieggen with the teaching of Kojima to make an ash collector that can be easily used in a dimly-lit place (column 1, lines 38-39). Accordingly, claim 20 is rejected.

Regarding claims 19 and 21, Sieggen fails to teach that in addition to a chamber intended to collect ashes the ash collector comprises second chamber that is accessible from the end of the container opposite the closure body. However, it would have been obvious to one of ordinary skill in the art at the time of invention to make the container such that it would have a separate compartment for collecting ashes and a separate compartment for the flashlight so that the flashlight would not be harmed or affected by the cigarette/cigar ashes. Accordingly, claims 19 and 21 are rejected.

Regarding claim 22, Kojima teaches an ashtray with a light means including a light bulb. Kojima fails to teach that the end of the container opposite the closure body is provided with a sleeve which is detachably connected with the container. However, it would have been obvious to one of ordinary skill in the art at the time of the

Art Unit: 1731

invention for the sleeve to be detachably connected so that the bulb may be changed or replaced. Accordingly, claim 22 is rejected.

Regarding claim 23, due to a lack of criticality and unexpected results, the sleeve further accommodating a reflector and a glass pane closing of the sleeve is a matter of design choice. Accordingly, claim 23 is rejected.

10. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sieggen in view of Hernlein (U.S. Patent No. 5,605,226).

Regarding claim 24, Sieggen fails to teach the ash collector comprising an integrated cigarette lighter. However, Hernlein teaches that ashtrays or ash collectors may be combined in one device with other smoker's accessories, such as cigarette lighters. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Sieggen with the teaching of Hernlein in one appliance as a matter of convenience to the smoker (column 1, lines 24-32).

Accordingly, claim 24 is rejected.

Regarding claim 25, Sieggen and Hernlein fail to teach the cigarette lighter provided in the second chamber. However, it would have been obvious to one of ordinary skill in the art at the time of invention to make the container such that it would have a separate compartment for collecting ashes and a separate compartment for the cigarette lighter so that the cigarette lighter would not be harmed or affected by the cigarette/cigar ashes. Accordingly, claim 25 is rejected.

Regarding claim 26 and 27, Sieggen fails to teach that a removable cap that is pivotally mounted on the container protects the cigarette lighter. However, due to a lack

Art Unit: 1731

of criticality and unexpected results, the cigarette lighter being protected by a removable cap that is pivotally mounted on the container is a matter of design choice. Accordingly, claims 26 and 27 are rejected.

Response to Arguments

11. Applicant's arguments filed 12/14/2005 have been fully considered but they are not persuasive.

- Applicant argues that Sieggen does not teach or suggest an ash collector with all the limitations of claim 1 and 11, but the Examiner disagrees - as stated in the above rejections. While Sieggen may not explicitly state the exact recitation of the claimed invention as it relates to the thermal capacity's ability to ensure extinguishment within a few seconds, and the closure body's temperature to be below 50 C, it is believed, by the Examiner, that the Sieggen extinguisher accomplishes the same functions as that of the claimed ash collector, namely because the structure of the device, as claimed, and that disclosed in Sieggen are the same, and the goals accomplished, that of preventing heat to be felt on the exterior by the user, are similar as well.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone

Art Unit: 1731

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dionne Walls Mayes
Primary Examiner
Art Unit 1731

February 9, 2006